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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,981	12/10/2003	Atsushi Yamaguchi	041465-5114-01	5132
9629	7590	08/11/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			TRAN, THANG V	
			ART UNIT	PAPER NUMBER

2653

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/730,981

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Thang V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/911,424.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The amendment dated    has been considered with the following results:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description of the subject matters of: “all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering line formed by the phase pit string”, newly added in claim 11; “the second area forming device cuts the phase pit string so that all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering lines formed by the phase pit string”, newly added in claim 22; “the second area forming process cuts the phase pit string so that all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering line formed by the phase pit string”, newly added in claim 28; and “all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering line formed by the phase pit string”, newly added in claim 34, are not contained in the original specification.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11, 22, 28 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogata et al. (US 5,940,364).

Regarding claim 11, see Figs. 14-16 and 20 of Ogata et al. which show a recording medium (see Fig. 20) comprising; a first area (201 or 202) including meandering groove tracks (see Fig. 16a) on which information is recorded; and a second area (211 or 212) where a phase pit string corresponding to control data is arranged meanderingly (see Fig. 15a) , and wherein the meandering amplitude of the second area is different from the meandering amplitude of the first area (see column 13, lines 53-66 and column 15, lines 59-21). Note: the limitation “all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering line formed by the phase pit string”, newly added in the claim, is considered as a new matter added in the claim; therefore, no patentable weight is given thereto. However, Applicant’s attention is drawn to Fig. 8 of the US Patent 6,582,793 cited herewith for the teaching of the above limitation.

Regarding claims 22 and 28, see the rejection applied to claim 11 above and further see Fig. 4 or 5.

Regarding claim 34, see the rejection applied to claim 11 above and further see Fig. 7, 8 or 12 and Fig. 21.

Regarding claim 35-37, see column 14, lines 55-60.

*Allowable Subject Matter*

5. Claims 12-21, 23-27, 29-33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

6. Claims 12-21, 23-27, 29-33 are allowable over the prior art of record because the prior art of record, considered in combination or individually, fails to suggest or fair teach a recording medium including a combination of all limitations as particularly recited in each of claims 12, 13, 23, 24, 29 and 30. Claims 14-21, 25-27 and 31-33 are allowable with their respective parent claim.

*Response to Arguments*

7. In response to Applicant's arguments filed 05/16/05, Applicant should note that Applicant argues limitations that are not contained in the specification. Therefore, the limitation "all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering line formed by the phase pit string" cannot be read into the claims for the purpose of avoiding the prior art. Accordingly, Ogota et al does show all the limitations as recited in the claims since the limitation "all pits forming the phase pit string have identical widths in a direction perpendicular to a meandering line formed by the phase pit string" is not read into the claims and given any patentable weight.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Cited references*

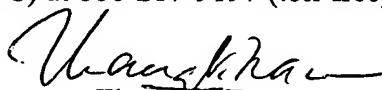
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate to a recording medium having a first area including a wobble groove and a second area including a second wobble groove or phase pit string whose wobble amplitude is different from that of the first area.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thang V. Tran  
Primary Examiner  
Art Unit 2653